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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,706	11/09/2001	Stephan Gutmann	PI/5-30958A/C1	5651
7590	06/17/2002			
EXAMINER				
BALASUBRAMANIAN, VENKATARAMAN				
ART UNIT				
1624				
DATE MAILED: 06/17/2002				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/039,706	GUTMANN, STEPHAN
	Examiner Venkataraman Balasubramanian	Art Unit 1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 09 November 2001.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-5 and 10-12 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-5 and 10-12 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## DETAILED ACTION

Applicants' preliminary amendment, which included cancellation of claims 6-9, amendment to claims 4-5 and addition of new claims 10-12, filed on 11/9/2001, is made of record. Claims 1-5 and 10-12 are now pending.

### *Priority*

Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Switzerland on 5/12/1999 and 9/3/1999. It is noted, however, that applicant has not filed a certified copy of the foreign applications as required by 35 U.S.C. 119(b).

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 and 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Following reasons apply. Any claim not specifically rejected is rejected as being dependent on a rejected claim.

1. Recitation of the terms "signify" or "signifies" in claim 1 and 2 renders these claims indefinite as these terms implies more than what is being positively recited therein.
2. Claim 1 also recites "Compounds of formula" which implies that the claim is composition claim not a compound claim. An appropriate correction or clarification is needed.

3. Claim 1 also recites “ and tautomers thereof” which is improper Markush recitation of choices. Note Markush choices should be in alternate form.
4. Claim 12 recites the limitation “pesticidal compositions as described in claim 4” in line 1. There is insufficient antecedent basis for this limitation in claim 4. Note claim 4 recites only “pesticidal composition” not “pesticidal compositions”.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4-5, 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kristinsson US 4,931,439.

Kristinsson teaches the same compound –pymetrozone-, as noted in the instant specification and cited in the Information Disclosure Statement for the use as pesticide. Kristinsson also teaches that the said compound can be used in formulation with suitable solvents, which include those solvents claimed in the instant claims. See col. 5, lines 25- 45. Since the formulation as such is a solution, there is no distinction between using a hydrate or methaonlate etc. of instant compound with the recrystallised product of Kristinsson. There is no reason to believe that the instant formulation would behave differently from those of Kristinsson. Hence this rejection is applicable. Note In re Petering et al 133 USPQ 275; In Re Schaumann, 195 USPQ 5.

***Allowable Subject Matter***

Claims 1-3 and 11 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action. Said claims would be allowed since specific species embraced in these claims are not taught or suggested by the art of record or from a search in the relevant art area.

References cited in the Information Disclosure Statement (paper # 3) are made of record.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is Mukund Shah whose telephone number is (703) 308-4716.

The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

*V. Balasubramanian*  
Venkataraman Balasubramanian

6/15/2002